

REMARKS/ARGUMENTS

Claims 20 and 22-42 remain in the application for further prosecution. Claims 1-19 and 21 have been cancelled in prior amendments.

§ 103 Rejections

Claims 20 and 22-42 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2005/0192090 A1 to Muir *et al.* (“Muir”), U.S. Patent No. 5,673,128 to Ohta *et al.* (“Ohta”), and U.S. Patent Application No. 6,638,165 B2 to Uchiyama *et al.* to (“Uchiyama”). Applicant respectfully requests withdrawal of this rejection for the reasons discussed below.

The Examiner’s Inherency Argument Regarding the “Diffusion Layer” is Flawed

In the final Office Action, the Examiner acknowledges that Muir fails to disclose several details of the claimed invention.

The display device taught by Muir does not specifically teach a light guide plate disposed between the transparent liquid crystal display panel and the variable display device, the light guiding plate for guiding light from a lateral of the guide guiding plate to a rear side of the transparent panel, the light having been emitted from a light source via the backlighting panel.

Final Office Action, p. 6.

However, Muir is silent specifically describing a light guiding plate and a rear holder to be provided with openings respectively at a position corresponding to the display window.

Final Office Action, p. 7.

Muir is silent with respect to producing an effect on a portion other than the display window and the specific use of a diffusion sheet incorporated into a LCD display.

Final Office Action, p. 8. To overcome these deficiencies in Muir, and especially the lack of the distinct “diffusion layer” in each of the independent claims, the Examiner resorts to the teachings of Ohta because “the implementation of a diffusions sheet or light guiding plate is not a change or modification of the Muir reference. These elements are basic elements of the disclosed LCD display device.” Final Office Action, p. 3. Then, when relying on Ohta to explain why Muir’s LCD must include the “inherent” diffusion layer, the Examiner relies on Figure 1 at the top of page 4 that is NOT from Ohta’s disclosure. The Examiner then concludes “it is through this teaching that shows how Muir’s disclosed LCD display incorporates the claimed elements of a diffusion sheet and light guiding plate though the use of an LCD display.” Final Office Action, p. 4. This is certainly not a legally acceptable manner in which to develop a prior art rejection based on inherency.

More importantly, the facts at hand do not support the Examiner’s position that Muir inherently includes the claimed “diffusion layer.” Muir teaches an LCD display device that involves an edge-lit system, not a back-lit system. In other words, the illuminating elements 83 in Muir are at the top edge and bottom edge of the light panel 84. While the Examiner continues to assert that diffusion layers are inherent in all LCD displays, the fact of the matter is that a distinct diffusion layer is not required to make an LCD display operate, at least in edge-lit systems. For example, Exhibit 1 (attached) discusses the difference between edge-lit LCD’s and back-lit LCD’s and notes that a light guide plate in an edge-lit LCD can be configured such that “a diffuser panel is not required.” Ex. 1, p. 2. See also U.S. Patent Application Publication No. 2010/0321609 entitled “Edge-Lit Backlight Unit with Thin Profile” (discussing the omission of the diffusion layer in alternative embodiments). Ex. 2 at ¶¶ 70-73. Furthermore, the backlighting of an LCD is not a binary feature in which “you have it or you don’t.” There are varying degrees of backlighting, all of which provide some level of backlighting (a lot or a little)

depending on the type of functionality needed by the system. Even Muir himself acknowledges this fact by noting “[T]he visual impact imparted by the LCD is enhanced by an illuminating layer in the form of a backlighting arrangement 82.” Muir, ¶66. By noting the backlighting arrangement 82 “enhances” the LCD’s visual impact, Muir is teaching that LCD has some visual impact and is functional without the backlighting. In summary, contrary to the Examiner’s suggestion, it is known that LCDs can have different backlighting arrangements, some of which may not require a separate diffusion layer (just like Muir’s LCD system).

While Muir’s explicit teaching for the construction of his LCD 50 is clear, the basis for Muir’s reasoning for constructing his LCD 50 in the manner that he chose is not as clear. Knowing that a player needed to see the reels behind the LCD 50, perhaps Muir specifically chose to exclude a diffusion layer adjacent to the light panel 84 to provide a clearer viewing of the reels. Perhaps an evenly lit (or well lit) LCD was not a requirement for Muir. Or, perhaps Muir knew that he could utilize the shutter 76 that is directly adjacent to the light panel 84 to help diffuse some of the light from the illuminating elements 83 or provide additional lighting contrast, thereby resulting in more visually perceptible images across the LCD panel 68. It is noteworthy that Muir’s shutter 76 is formed of a NCAP liquid crystal, which by itself could enhance the lighting contrast with the front LCD panel 68. The Applicant (and the Examiner) could speculate about the reasons why Muir selected the LCD construction that he did. But, the only thing that really matters for this current analysis is what Muir did, in fact, explicitly teach.

As noted in the MPEP, it is the Examiner’s burden to prove that the prior art inherently includes the missing claim element.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666

F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. ..."

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.

MPEP §2112 (emphasis added). The Applicant has now provided the Examiner with evidence that not all LCDs "necessarily" require a separate diffusion layer. The inclusion of a separate diffusion layer is, at best, a "possibility" which cannot serve as a basis for inherency. In summary, the Examiner has failed to meet his burden regarding the issue of inherency and the rejection fails on that reason alone.

Muir's "Inherent" Diffusion Layer Lacks the Claimed "Openings"

As noted in the previous reply, even if the Examiner's inherency argument regarding the claimed "diffusion layer" were correct (which it is not), that argument could not be extended to then force the inherent diffusion layer to include "openings" as required by many of the claims. That is an improper basis for a rejection which is grounded in hindsight. The Examiner has focused on the pending claims and constructed this rejection by taking what Muir does not disclose (i.e., a diffusion layer) and then modifying Muir's undisclosed feature to match it with

the claims. These facts strongly suggest the current rejection is based on a hindsight reconstruction of the claims in which the Applicant's own specification has been used as the blueprint for the rejection. See MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). The Applicant respectfully requests the Examiner to reconsider this position.

Muir's Light Panel 84 Lacks the Claimed "Openings"

According to the Examiner, the light panel 84 is the claimed "light guiding plate." Because Muir's light panel 84 is illustrated as a solid unitary piece, the Examiner further suggests that the skilled artisan would have obviously placed openings in that backlighting panel 84, as required by many of the claims.

Muir's had a reason to include no openings in its lighting panel 84. Muir teaches that the shutter 76 is present to provide an opaque structure behind Muir's LCD 50, such that the shutter 76 occludes the viewing of the symbols on the reels 18. Muir, ¶65. Accordingly, Muir's desire was to provide an alternative game play on the LCD 50 such that the alternative "game play is to be effected using the LCD 50 alone" when the shutter 76 is opaque. Muir, ¶67. If the lighting panel 84 were provided with the hypothetical openings as suggested by the Examiner, then it would create an inconsistent backlighting for Muir's LCD, leading to the inside edges (which have a thickness) of the Examiner's hypothetical openings being viewable in sharp contrast to the opaque (i.e., darkened) shutter 76 located directly therebehind. Impairing the presentation of the alternative game play on the LCD is surely not what Muir had in mind. Accordingly, the Examiner's solution (i.e., the Examiner's motivation¹ to add openings) to the alleged problem of

¹ The Examiner's suggestion that providing openings will also save material costs ignores the fundamental fact of the increased manufacturing costs to actually create these openings.

“obstruction of symbols by another display device disposed in front of the symbol display device” (Final Office Action, pp. 4-5) creates an entirely different problem of impairing the presentation of the alternative game play on Muir’s LCD 50. In summary, the Examiner’s alteration of Muir’s LCD construction should not override the specific LCD construction that Muir, himself, chose.

Accordingly, all of the claims are patentable over any proposed combination involving Muir because a *prima facie* case of obviousness has not been established. Consequently, the Applicant respectfully requests that the current rejection be removed and a Notice of Allowance be issued.

Conclusion

It is the Applicant’s belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000772USPT.

Respectfully submitted,

Date: October 27, 2011

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